

REMARKS

This Amendment is filed concurrently with a Notice of Appeal in the above referenced application.

Claims 36-50 are pending in this application. Claims 39, 44 and 49 are amended herein to incorporate features previously recited in claims 40, 45 and 50. Claims 40, 45 and 50 are accordingly cancelled.

Therefore, claims 36-39, 41-44 and 46-49 remain pending in this application, of which claims 36, 37, 39, 41, 42, 44, 46, 47, and 49 are independent.

Claims 36-40 stand rejected under 35 U.S.C. §101, as directed to non-statutory subject matter. The rejection is respectfully traversed.

The previously presented traversal arguments are incorporated herein in their entirety by reference.

In the Response to Arguments on pages 2-5 of the Final Official Action, the Examiner now alleges that claims 36-40 fail to produce a useful, concrete and tangible result. The Examiner's contention is not understood in view of the relevant law. Furthermore, the Examiner asserts conclusions without any analysis supporting these conclusions in view of the relevant law. Accordingly, no prima facie basis for the rejection has been presented.

The Examiner, for reasons which cannot be understood, refuses to accept the common modern definition of "database" and "processing" as evidenced by Microsoft Computer Dictionary, but instead chooses to rely on an over forty year old definition found in a 1962 Webster Dictionary to support a contention that the recited invention is not in the "technological art", and would not be understood as such by those skilled in the art. Indeed, one need only make a cursory review of the specification to understand that the master merchant file database, as has been defined in the specification, is a computer

database which includes merchants identified by multiple different consumers.

Claims 36-50 stand rejected under 35 U.S.C. §103(a) as obvious over Lawlor et al. (U.S. Patent No. 5,220,51), in view of White et al. ("4-in-1 Accounting: The basics from Real-World" PC Magazine, v4, n20, p167-168, October 1, 1985). The rejection is respectfully traversed.

The previously presented traversal arguments are incorporated herein in their entirety by reference.

In the Examiner's response to arguments (on pages 5-8 of the Final Official Action), the Examiner now contends that Lawlor discloses the claimed master merchant database in column 14, lines 7-9, column 19, lines 19-53, and column 33, lines 24-34, pointing particularly to the mass storage device 84 of Figure 1A.

However, contrary to the Examiner's assertion, there is nothing in the reference text to suggest that the "mass storage device" 84 described by Lawlor even includes a "database".

The Examiner goes on to cite column 10, lines 66-69, in further support of the contention that Lawlor's "mass storage device" 84 somehow corresponds to the required master merchant database. In particular, the Examiner quotes from Lawlor that "to use bill paying features, customers provide the service provider in advance with a list of payees [names, account numbers, addresses] ...". However on its face, the quoted language fails to support the Examiner's contention.

Thus, the Examiner's conclusion that "it is clear that Lawlor discloses a master database "84" which includes plurality of merchants, their information is identified by multiple users and this information about merchants is used for bill payment on behalf of multiple users", is not supported by what the Examiner has identified and supporting of the conclusion. The Examiner's attention is again directed to Figures 14A-14C of

Lawlor, and the related text in column 42, line 60, through column 43, line 25, where Lawlor himself contradicts what the Examiner contends to be disclosed by Lawlor.

The Examiner's arguments in the first full paragraph on page 6 of the Final Official Action, ignore what the claims require the master merchant database to be searched for. Contrary to the Examiner's contention, the claims do not simply require that a list of merchants be searched for any reason whatsoever.

Rather, to the extent searching is required by the claims, that searching is required for a very particular purpose. For example, claim 37 requires the searching of a master merchant file database to determine if information associated with one of multiple identified merchants in a list received from a consumer is included in the database.

Furthermore, the Lawlor disclosure quoted by the Examiner from column 43, lines 25-46 discloses only the searching of a list, and lacks any disclosure whatsoever of the searching of a database. Hence, the relied upon disclosure lacks any relevance with respect to the present claims.

With regard to the Examiner's contentions on pages 7 and 8, it should first be noted that White, like Lawlor, lacks a master merchant file database. Furthermore, it is unclear why the Examiner considers White's manual addition of a vendor to be relevant. For example, claim 42 requires that a processor add the merchant to the master merchant file database if the merchant is determined by the processor not to be included, which is entirely different than White's system which "allows you [the user] to add a vendor".

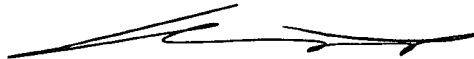
Accordingly, it should be understood that the amendments presented herein are not made for purposes of patentability. Rather, the amendments are made solely to reduce the number of claims and issues to be addressed on Appeal.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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